Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS L. ROLLINS

Appeal No. 2003-1600
Application No. 09/272,845

ON BRIEF

Before HAIRSTON, KRASS, and GROSS, ***Administrative Patent Judges***.
GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 32 and 41 through 44.[1]

Appellant's invention relates to a method for automatically updating software modules on a computer system by determining if a more current version is available and compatible with the circuitry of the computer. Claim 1 is illustrative of the claimed invention, and it reads as follows:

[1] Appellant filed an amendment on April 9, 2002, canceling claims 33 through 40, and the examiner has not indicated whether or not the amendment has been entered. In any event, claims 33 through 40 are not before us on appeal.

1. A method comprising:

identifying a first version of a software module, the software module being installed on a computer system and being associated with circuitry of the computer system;

identifying a second version of the software module;

automatically determining whether the second version is more current than the first version and whether the second version is compatible with the circuitry; and

indicating the result of the determination.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Apfel et al. (Apfel)	5,974,454	Oct. 26, 1999 (filed Nov. 14, 1997)
Furner et al. (Furner)	5,974,474	Oct. 26, 1999 (filed Mar. 14, 1997)

Claims 1 through 32 and 41 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Apfel in view of Furner.

Reference is made to the Examiner's Answer (Paper No. 11, mailed December 3, 2002) for the examiner's complete reasoning in support of the rejection, and to appellant's Brief (Paper No. 10, filed August 15, 2002) and Reply Brief (Paper No. 12, filed February 10, 2003) for appellant's arguments thereagainst.

OPINION

As a preliminary matter, we note that on page 8 of the Brief, appellant indicates that each of the two independent

claims (claims 1 and 17) along with its respective dependent claims is to be treated as a separate group. However, the arguments for the second group (at pages 11-12 of the Brief) are the same as those for the first group. Accordingly, we will treat the claims as a single group with claim 1 as representative.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 1 through 32 and 41 through 44.

The only limitation of claim 1 which is at issue is "automatically determining . . . whether the second version is compatible with the circuitry [of the computer system]." The examiner (Final Rejection, page 5) states that Apfel "doesn't expressly disclose software module being associated with circuitry," and thus turns to Furner to remedy the deficiency. However, the examiner (Answer, page 4) points to column 7, lines 16-20 of Apfel, which discloses not downloading an upgrade if it is incompatible with the computer. The examiner equates "the computer" with the claimed circuitry.

Appellant contends (Brief, page 9) that "Apfel, however, does not disclose determining whether a second version of a software module is compatible with circuitry that is associated with the software module." Appellant makes the same argument in the Reply Brief (at page 2). Appellant continues (Brief, page 3) that Apfel (at column 7, lines 15-25) "does not discuss circuitry as being incompatible with a software upgrade," but rather "one skilled in the art may recognize that the incompatibility Apfel is referring to [sic, is] the incompatibility of upgrade software to other software of the computer . . . . The language does not state that the incompatibility is with hardware or circuitry of the computer system."

We disagree with appellant that Apfel is concerned solely with the compatibility of the update with the other software of the computer. Appellant suggests that because "[t]he language does not state that the incompatibility is with hardware or circuitry of the computer system," that Apfel must be talking about software. However, the language of Apfel does not state that the incompatibility is with the software. The language states that the incompatibility is with "the computer." Computer 20 is defined (column 4, lines 15-30) as including "a processor unit 21, a system memory 22, and a system bus 23," and further

includes a hard disk drive 27, a magnetic disk drive 28, . . . and an optical disk drive 30." Thus, the language of Apfel, "the computer," would seem to suggest hardware rather than software. However, the skilled artisan would have recognized that compatibility with the computer would need to be with all aspects of the computer (both hardware and software). The level of the skilled artisan should not be underestimated. ***See In re Sovish***, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Accordingly, we find that Apfel alone meets all of the limitations of the claims, with Furner merely being cumulative.

The remaining arguments of appellant (in both the Brief and the Reply Brief) relate to the teachings of Furner and the motivation to combine Apfel with Furner. As we have found that Apfel satisfies all of the limitations of the claims, the arguments regarding Furner and motivation to combine are considered moot. Accordingly, we will sustain the obviousness rejection of all of the claims.

CONCLUSION

The decision of the examiner rejecting claims 1 through 32 and 41 through 44 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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ERROL A. KRASS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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ANITA PELLMAN GROSS)
Administrative Patent Judge)

AGP/RWK

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COE F MILES
TROP PRUNER HU & MILES
8554 KATY FREEWAY STE 100
HOUSTON, TX 77024